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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,682	10/05/2001	Jerome Fournier	Q66648	1857

7590 06/15/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/970,682	FOURNIER ET AL.	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,5,6,8-20,24,26,27 and 29-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,5,6,8-20,24,26,27 and 29-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The indicated allowability of claims 8, 12, 16-18 and 29-32 has been withdrawn upon further consideration.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 3, 5-6, 8-20, 24, 26-27, and 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger 4,499,149, for reasons of record.

Berger is as set forth previously and teaches siloxane containing polymers comprising mineral fillers and method of making, per claims 3, 9-10,13-14, 16, 24, and 30. The polymers can be polyimide, polyamideimide, polyester or polyurethane. See abstract, column 2, lines 43-45, and column 54, lines 47-48. The polyimides are suitable as wire enamel and contain mineral fillers of the type contemplated by applicants in claims 5-6, 19, 26-27, and 33 (see column 36, lines 5-10). In addition, Example XXXV of Berger teaches the synthesis of the polyimide coating performed using N-methylpyrrolidone solvent as required by claim 11, and Example XXXVII teaches applying this coating on a wire and setting the coating and that said coatings are useful in the manufacturing of windings, as required by claims 13 and 14-15.

Berger additionally teaches that solutions of polyamideimides containing siloxanes can be applied to electrical conductors such as wires because of their high temperature resistance and corona resistance, as contemplated by applicants in claims 13 and 14. See column 39, lines 48-57. The siloxanes of Berger are formed from alkoxysilanes, including a methoxysilane, see column 67, lines 52-59. It should be noted that applicants' claim language in claim 9 of "a copolymer obtained from a thermoplastic or thermosetting resin and at least one alkoxysilane" does not exclude copolymers wherein the alkoxysilane is a precursor or intermediate. As to the specific alkoxysilane required by claims 9, 17, and 31, it is the position of the examiner that this constitutes no more than a preferential selection of one alkoxysilane from among many, being selected for their art recognized purpose. There is no clear evidence on this record of patentably distinguishable properties in the instant varnish, said properties being directly related to the specific alkoxysilane. As to claims 20 and 34, it is the position of the examiner that since the result sought and the ingredients used were known, it was within the expected skills of one having ordinary skill in this art to arrive at the optimum proportion of those ingredients during routine experimentation. Regarding claim 8 and 29, these claims are drawn to the size of the particles, which ordinarily is not a matter of invention. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). As to claim 12, the inclusion of catalyst to assist in polymerization processes is well known in the art as well as the selection of a catalyst based upon the start materials and processing conditions. Hence, the selection of the instant claimed catalyst from among many is construed to be no more than a preferential selection of one from among many being selected for its art

recognized purpose, in the absence of factual evidence on this record of unexpected or superior properties of the resultant varnish and wire, said unexpected or superior properties being directly related to the specific catalyst. As to claims 18 and 32, it would have been obvious to include titanium dioxide to aid in preventing degradation of the polymer and to function as a whitener.

Berger is silent as to the property of the winding wire being able to withstand peak-to-peak voltages of up to 3 kV at a frequency of up to 20 kHz with rise times of up to 1 kV/μs at a temperature of up to 108°C in claims 9 and 14. In this regard, the composition of Berger is the same as or substantially similar to that contemplated by applicants. Accordingly, the examiner has reason to believe that the properties such as peak-to-peak voltages are the same as well, in the absence of clear factual evidence to the contrary. In the alternative, it would have been obvious to adjust the properties of the insulation by adjusting the amount of mineral filler present in the composition. Also, since a composition of the type contemplated by applicants is known, it is the examiner's position that since the results sought and the ingredients used were known, it was within the expected skills of one having ordinary skill in the art to arrive at the optimum proportion of those ingredients. As set forth previously, the composition of the prior art substantially similar to that contemplated by applicants, and there is no clear factual evidence on this record by way of back-to-back comparison that the prior art does not have the claimed critical peak-to-peak voltages.

Therefore, the teachings of Berger would have rendered obvious the invention as claimed in present claims 3, 5-6, 8-20, 24, 26-27, and 29-34.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jill M. Gray
Primary Examiner
Art Unit 1774

jmg